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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,973	08/05/2003	Kurt E. Spears	10019217-1	6938

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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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12/01/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/634,973	Applicant(s) SPEARS ET AL.	
	Examiner HOUSHANG SAFAIPOUR	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-21,29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 31-38 is/are allowed.
- 6) ☒ Claim(s) 1, 4-21 and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, related to claims 1, 4-17 and 39-41, filed on July 27, 2008 have been fully considered and they are not persuasive.

Regarding claims 1, 39 and 41, applicant argues that "Hidetoshi, however, never teaches or even suggests that both carriages independently move along their displacement paths" and further argues that he "...never teaches or even suggests that these carriages also move such that positions of their respective paths are not same at any given time. Takashi fails to cure these deficiencies." Examiner respectfully disagrees. Hidetoshi discloses that translation of carriage 5b starts when movement of carriage 5a ends (please refer to paragraphs [0041-0043].

Regarding claims 1 and 40, applicant argues that "...neither Hidetoshi nor Takashi teach or even suggest offsetting the modules to reduce bleed-through of light through an object." Examiner respectfully disagrees. Hidetoshi discloses means to prevent "back projection" which is the term used for "bleed through" (please refer to paragraphs [0054-0057]).

For the reasons stated, examiner maintains his rejection of claims 1, 4-17 and 39-41.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2625

2. Claims 1, 4-17 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda Hidetoshi (JP 10-098588, cited by the applicant) and further in view of Koshiyouji Takashi (JP 07-254972, cited by the applicant).

Regarding claims 1 and 39, Hidetoshi discloses an image capture device, comprising:
a first scanning module (5a) operable to scan a first side of an object (manuscript 1); and
a second scanning module (5b) operable to scan a second side of said object, said first and second scanning modules being independently translatable along their respective displacement paths (drawing 1, paragraphs 0038-0041) and being offset from each other along their respective displacement paths during a duplex mode to reduce bleed-through of light through the object [0054-0057]; and

a housing (drawing 1, lower unit), wherein one of said first and second scanning modules (5a) is disposed in said housing (drawing 1). (Takashi shows a housing and lid coupled together).

Regarding claim 4, Hidetoshi discloses the image capture device of claim 1, further comprising a lid coupled to a housing, one of said first and second scanning modules being disposed in said lid (drawing 1, upper unit is considered as a lid. It is not shown that the upper unit is coupled to the lower unit, however, such structure is well known as shown in drawings 1 and 2 of Takashi).

Regarding claim 5, Hidetoshi discloses the image capture device of claim 1, further comprising two platens operable to sandwich said object there between (drawing 1, where manuscript 1 is placed).

Art Unit: 2625

Regarding claim 6, Hidetoshi discloses the image capture device of claim 4, said scanning module disposed in said lid being mounted on at least one support rail (6b, drawing 1) in said lid.

Regarding claim 7, Hidetoshi discloses the image capture device of claim 3, said second scanning module disposed in said housing being mounted on at least one support (6a, drawing 1) rail in said housing.

Regarding claim 8, Hidetoshi discloses the image capture device of claim 1, wherein said first scanning module (5b) comprises:

- a light source (12b, drawing 1) operable to illuminate at least a portion of said first side;
- and

- a photosensitive device (17b, drawing 1) operable to capture light reflected from said first side.

Regarding claim 9, Hidetoshi discloses the image capture device of claim 1, wherein said first scanning module comprises a photosensitive device (17b, drawing 1) operable to capture light passing through said object.

Regarding claim 10, Hidetoshi discloses the image capture device of claim 1, wherein said second scanning module (5a) comprises:

- a light source (12a) operable to illuminate at least a portion of said second side; and
- a photosensitive device (17a) operable to capture light reflected from said second side (drawing 1).

Art Unit: 2625

Regarding claim 11, Hidetoshi discloses the image capture device of claim 1, wherein said second scanning module comprises a photosensitive device (17a) operable to capture light passing through said object.

Regarding claims 12-15 please refer to paragraphs [0037-0041 of Hidetoshi].

Regarding claims 16 and 17, Hidetoshi does not explicitly disclose scanning a transparent document, however, Takashi discloses such scanning. As shown in drawing 1, one of the two scanning modules illuminates the object and the other module captures the light passing through the object. Therefore it would have been obvious to a person of ordinary skill in the art to modify Hidetoshi's scanning apparatus to include transparency scanning.

Regarding claims 40 and 41, please refer to the arguments under claim 1 and 16.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-21 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101" – publicly available at uspto.gov, "memorandum to examining corp").

Art Unit: 2625

Claims 18-21 neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for process to be "tied" to another statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

Allowable Subject Matter

Claims 29 and 31-38 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2625

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Houshang Safaipoor/
Primary Examiner, Art Unit 2625